UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
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ART UNIT	PAPER NUMBER
2135	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

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	Application No.	Applicant(s)
Office Action Summary	10/666,411	SAFA, JOHN ARAM
	Examiner	Art Unit	
	NIRAV PATEL	2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>06 December 2007 (Amendment)</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>41-64</u> is/are pending in the application.

    4a) Of the above claim(s) <u>53-61,63 and 64</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>41-52 and 62</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1. This action is in response to the communication filed on 12/06/2007.

2. Claims 41-64 are pending. Claims 41-44, 45-52 and 62, which correspond to species 1 are elected with traverse for immediate examination.

Election/Restrictions

3. Applicant's election on species 1 with traverse in the reply filed on Dec. 06, 2007 is acknowledged. Because each of the various disclosed species details a mutual exclusive characteristic of:

- A method/a software protection arrangement of/for protecting software to be run on a wireless device operable for communication with a server over a wireless network, the protected software being provided in encrypted form and requiring a decryption key for successful execution.

- A wireless device operable for communication with an authentication server over a wireless network, the wireless device storing protected software in encrypted form.

- A server operable for communication with a wireless device over a wireless network, the server storing a decryption key for decrypting protected software stored on the wireless device.

A search for one of these mutually exclusive characteristics, as a whole, is not coextensive with a search for the other mutually exclusive characteristics and therefore searching for all mutually exclusive characteristics could not be done without serious

burden. Where there is no disclosure of a relationship between species (see MPEP §

806.04(b)), they are independent inventions. A requirement for restriction is permissible

if there is a patentable difference between the species as claimed and there would be a

serious burden on the examiner if restriction is not required. See MPEP § 803 and

§ 808.02 [M.P.E.P. 808.01 (a), 809.02 (a)].

The requirement is still deemed proper and is therefore made **FINAL**.

Claim Objections

4. Claim 51 is objected to because of the following informalities:

Claim 51 recites "**An arrangement according to claim 51**". The claim 51 depends on

itself, which is improper form of dependent claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 45-52 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter.

Claim 45 recites "A software protection arrangement for protecting software to be run on a wireless device operable for communication over wireless network....., and the arrangement including: identifying means operable to create an identifier......; an authorization server operable to receive an identifier....; enabling means operable to receive the derived identifier........". In accordance with page 3 [paragraph 0021] and page 12 [paragraph 0067] of applicant's specification, claimed modules are provided by software elements. As such, the claimed system must include hardware or physical transformation necessary to realize any of the functionality of the claimed modules and produce a useful, concrete and tangible result. Absent recitation of such hardware or physical transformation as part of the claimed arrangements, it is considered non-statutory.

Claims 46-52 depend on claim 45, therefore they are rejected with the same rationale applied against claim 45 above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 41-44, 45-52 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu et al (US Patent No. 6,684,198) in view of Hughes (US Pub. No. 2001/0044782) in view of Mittal et al (US Patent No. 6,952,770) and in view of Yeung et al (US Patent No. 6,668,246).

As per claim 41, Shimizu teaches:

verifying at the server that use of the protected software by the wireless device is authorized [col. 4 lines 36-47]; in response to the verification, transmitting the decryption key request and transmitting the decryption key to the wireless device [Fig. 4, col. 4 lines 48-56]; obtaining the decryption key, decrypting at the wireless device the encrypted software using the decrypted key to enable execution of the protected software [Fig. 3, 4, col. 4 lines 57-65].

Hughes teaches creating at the wireless device an identifier which characterizes the device [Fig. 2, paragraph 0036]; transmitting the identifier from the wireless device to the server, transmitting the derived identifier from the server to the wireless device [Fig. 2]; wherein successful execution of the protected software is achieved only in the event that the derived identifier has been formed by the predetermined function operating on the identifier of the wireless device on which the protected software is to be run [paragraph 0041-0043, Fig. 4].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Hughes with Shimizu, since one would have been

motivated to preventing piracy or illicit use of software by identifying hardware components of a computer [Hughes, paragraph 002].

Mittal teaches:

the predetermined function operating on at least two variables, including the identifier receive from the device and decryption key [col. 3 lines 35-37, 66-67, Fig.2].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Mittal with Shimizu and Hughes, since one would have been motivated to prevent the unauthorized use of the content/software [Mittal, col. 2 lines 15-16].

Yeung teaches:

second predetermined function operating on at lease two variables, including the derived identifier and the identifier, to recover a decryption key [col. 6 lines 10-20].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Yeung with Shimizu, Hughes and Mittal, since one would have been motivated to protect the content/software in the content distribution system [Yeung, col. 1 lines 10-11].

As per claim 42, the rejection of claim 41 is incorporated and Shimizu teaches:

the server stores a plurality of decryption keys, each decryption key corresponding to respective protected software [col. 4 lines 52-55 Fig. 1].

Hughes teaches the identifier is created to include information characterizing the protected software [Fig. 2, paragraph 0036].

Mittal teaches: the derived identifier is formed by the predetermined function operating

on the identifier and the decryption key corresponding to the protected software

identified by the identifier [col. 3 lines 35-37, 66-67, Fig.2] .

As per claim 43, the rejection of claim 41 is incorporated and Hughes teaches

the identifier is derived from information which identifies hardware and/or software

present at the device [paragraph 0036].

As per claim 44, the rejection of claim 41 is incorporated and Shimizu teaches verifying

that use of the protected software by the wireless device is authorized comprises

effecting a financial transaction or credit check before allowing execution of the

predetermined function [col. 5 lines 6-13].

As per claim 45, it encompasses limitations that are similar to limitations of claim 41.

Thus, it is rejected with the same rationale applied against claim 41 above.

As per claim 46, the rejection of claim 45 is incorporated and Shimizu teaches the

identifier further includes information characterizing the protected software, and the

authorization means is operable to select a decryption key corresponding to the

identified software [col. 4 lines 52-56].

As per claim 47, the rejection of claim 45 is incorporated and it encompasses limitations that are similar to limitations of claim 43. Thus, it is rejected with the same rationale applied against claim 43 above.

As per claim 48, the rejection of claim 45 is incorporated and it encompasses limitations that are similar to limitations of claim 44. Thus, it is rejected with the same rationale applied against claim 44 above.

As per claim 49 the rejection of claim 45 is incorporated and Hughes teaches:

the identifying means is operable to create an identifier as aforesaid on each occasion protected software is to run on the device [Fig. 4, paragraph 0042 lines 6-9].

As per claim 50, the rejection of claim 45 is incorporated and Hughes teaches:

the identifying means transmits identifiers to the authorisation means, over the wireless network [Fig. 2, paragraph 0026 lines 13-16].

As per claim 51, the rejection of claim 51 is incorporated and Hughes teaches:

the authorisation means is operable to transmit derived identifiers to the enabling means by means of the wireless network [Fig. 2, paragraph 0026 lines 13-16].

As per claim 52, the rejection of claim 45 is incorporated and Hughes teaches:

the enabling means and/or the identifying means are provided by software elements

associated with the protected software [Fig. 3, paragraph 0036 lines 1-3].

As per claim 62, it encompasses limitations that are similar to limitations of claim 45.

Thus, it is rejected with the same rationale applied against claim 45 above.

Response to Amendment

7. Applicant has canceled claims 1-40 and added new claims 41-64. Newly added

claims 41-44, 45-52 and 62 are elected for immediate examination, which necessitated

new ground of rejection. See new ground of rejection above.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action.   Accordingly, **THIS ACTION IS MADE FINAL**.   See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of
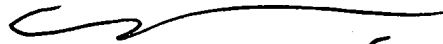
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nirav Patel whose telephone number is 571-272-5936. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax and phone numbers for the organization where this application or proceeding is assigned is 571-273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2100.

NBP

2/15/08

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2/17/08